

DEC 19 2001



UNITED STATES PATENT & TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Oppedahl & Larson
P.O. Box 5068
Dillon, CO 80435

In re Application of
Fong et al.

Application No.: 09/381556

PCT No.: PCT/US98/05505

Int. Filing Date: 20 March 1998

Priority Date: 21 March 1997

For: Rapid Production of Autologous Tumor
Vaccines by Using HIV Amplification Vectors

DECISION

This communication is in response to the "Response to Communication" filed on 22 September 2000.

BACKGROUND

On 20 March 1998, applicants filed international application PCT/US98/05505, which designated the United States and claimed a priority date of 21 March 1997. A Demand electing the United States was filed on 01 October 1998, which was prior to the elapse of 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired as of midnight on 21 September 1999.

On 21 September 1999, applicant filed a Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371 which was accompanied by, *inter alia*, the required basic national fee. The Transmittal Letter was not accompanied by an oath or declaration of the inventors.

On 01 November 1999, applicants filed a "Submission of Small Entity Statement And Request For Refund."

On 04 November 1999, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants. The Notification required the submission of an oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(e).

On 05 January 2000, applicants filed a "Response To Notice To File Missing Parts", an executed Declaration of the inventors, a check for \$120.00 and a postcard receipt. The postcard receipt and Response both indicated that the papers were directed to application number 09/045,476, rather than the instant application.

On 24 May 2000, applicants filed a "Letter" and attachments.

On 12 September 2000, a communication was transmitted to applicants.

On 22 September 2000, applicants filed the instant "Response to Communication," requesting that a review of the fees paid in this application be conducted.

DISCUSSION

A review of the fees paid in this application reveals that the following fees and amounts were paid on 21 September 1999:

Basic National Fee:	\$670.00
Extra Total Claims:	\$360.00
<u>Extra Indep.. Claims:</u>	<u>\$78.00</u>
Total:	\$1108.00

as well as the following fees:

Recordation:	\$80.00 (paid 29 November 1999)
Extension (1 month):	\$55.00 (paid 05 January 2000)
Surcharge (37 CFR 1.492(e)):	\$65.00 (paid 05 January 2000)

On 01 November 1999, applicants filed two verified small entity statements, and requested a "refund of one-half of the filing fee (\$554.00)." However, the small entity statement signed by James S. Quirk on behalf of Sloan-Kettering Institute for Cancer Research names Mr. Quirk as a person having rights to the invention, such that a separate verified statement averring to Mr. Quirk's small entity status would be required. Since no such statement averring to Mr. Quirk's individual small entity status has been provided, applicants have failed to establish small entity status in this application.¹ Therefore, the large entity fees as originally paid on 21 September 1999 are appropriate in this application. Meanwhile, since small entity status has not been established, applicants were required to pay the large entity extension of time fee (\$110.00 rather than \$55.00) and large entity surcharge under 37 CFR 1.492(e) (\$130.00 rather than \$65.00). Therefore, applicants are required to pay the \$120.00 shortfall in said fees. Moreover, on 24 February 2000, \$469.00 was inappropriately refunded to applicants. Applicants are further required to remit that \$469.00. Yet further, applicants have not yet paid the \$130.00 petition fee discussed in the Communication mailed on 12 September 2000. Accordingly, to correct the fee

¹ Former 37 CFR 1.27 and 1.28 govern the fee issues presented here.

status of this application, counsel's Deposit Account No. 15-0610 is being charged in the sum of \$719.00.

CONCLUSION

The request for refund is **REFUSED**, without prejudice.

This application is being forwarded to the National Stage Processing Branch to continue national stage processing.



Boris Milef
PCT Legal Examiner
PCT Legal Office



George Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459